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**RCE**  
**Notice of Allowability**

Application No.

10/625,101

Examiner

Michael P. Barker

Applicant(s)

ROTH ET AL.

Art Unit

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4/12/06.
2. ☒ The allowed claim(s) is/are 16-19.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>1</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date <u>11/21/03;4/12/06</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                                   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                                       | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance                  |
|  | 9. <input type="checkbox"/> Other _____.  |

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### **DETAILED ACTION**

Applicant has elected to cancel **Claims 1-15**. **Claims 16-19** are drawn to allowable subject matter and are in condition for allowance. The addition of **Claims 16-19** is acknowledged, and no new matter has been added by their addition.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2006 has been entered.

#### ***Information Disclosure Statement***

Applicant's information disclosure statement(s) (IDS), filed on November, 21 2003 and April 12, 2006 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it must be submitted no later than the payment of the issue fee.

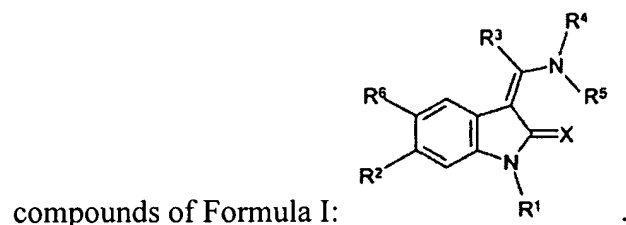
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Authorization for this examiner's amendment was given in a telephone interview with Mary-Ellen Devlin on January 30, 2006. The application has been amended as follows:

1. Cancel Claims 1-15.
2. Claim 19: After the words, "A compound", delete "have", and in its place, add "having".

### *Reasons for Allowance*

The present invention relates to compounds of Formula I, as well as methods of using



The novel and nonobvious aspect of this invention involves the substituents attached to the rings. While there is art which includes the core of Applicant's compound, none of the art claims the precise configuration of substituents as claimed in the instant application. No prior art has been found which precisely claims configuration of Applicant's instantly claimed invention.

The closest prior art is WO/200018734 [hereinafter, "Walter et al."]. Walter et al.

discloses compounds of the formula I:

. However,  $R_3$  of Walter et al. cannot be a phenyl group substituted by carboxy- $C_{1-3}$ -alkyl or  $C_{1-4}$ -alkoxy-carbonyl- $C_{1-3}$ -alkyl group as is claimed in the instant application. Further, the closest prior art does not

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disclose any species in the instantly claimed genus. Thus, seemingly, the only similarity between the closest prior art and the instantly claimed invention is the indolinone moiety. Thus, while similar to Applicant's claimed invention, Bernstein et al. does not teach or suggest Applicant's instantly claimed invention, nor does it provide motivation to one of ordinary skill in the art to synthesize a compound of the instantly claimed Formula I.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is viable through Private PAIR only. For more information about the PAIR system,

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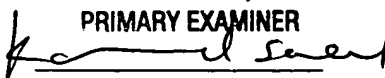
see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael P. Barker', written over a horizontal line.

Michael P. Barker  
Patent Examiner, AU 1626

KAMAL A. SAEED, PH.D.

PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Kamal A. Saeed', written over a horizontal line.

(for) Joseph McKane  
Supervisory Patent Examiner, AU 1626